

**Remarks/Arguments:**

**I. Status**

The Office Action dated December 24, 2008 (the “Office Action”), has been carefully reviewed. In the Office Action:

- A. Claims 24, 26, 31-35, and 39-42 were rejected under 35 U.S.C. § 102;
- B. Claim 25 was rejected under 35 U.S.C. § 103; and
- C. Claims 27-30, 36-38, 43, and 44 were objected to as depending from a rejected claim.

Reconsideration of this application is respectfully requested.

**II. 35 U.S.C. § 102 Rejections**

Claims 24, 26, 31-35, and 39-42 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,738,256 to Freeman et al. (hereinafter “Freeman”). The Applicants respectfully submit that Freeman does not disclose a bone miller system with the characteristics recited in the claims.

*Discussion re: Claim 24*

1. Claim 24

Claim 24 recites “a cutter mount configured to support the at least one cutter such that the cutter axis intersects the longitudinal axis at a first angle” and “a shaft alignment bracket configured to support the drive shaft at a fixed angular relationship with respect to the frame shaft such that the drive shaft axis intersects the cutter axis at a second angle,

wherein the second angle is about equal to or greater than the first angle.” Thus, two separate mounts are required which support 1) a cutter and 2) a drive shaft coupled to the cutter.

## 2. Freeman Discloses a Single Mount

The Examiner identified the component reference number 58 of Freeman as a “cutter mount” and the reference number “23” as a “shaft alignment bracket.” (Office Action at page 2). The fixed projecting arm 23 includes a ring 24 which supports the cutter 26 against longitudinal displacement. (Freeman at column 5, lines 10-18). Reference number 58, however, does not provide support to a drive shaft.

Freeman uses reference number 58 to identify a “locating pin.” (Freeman at column 5, lines 51-53). The pin 58 is a part of a “depth locating tool” that is used with a finding rod 60 (FIG. 13), a reamer (FIG. 14), and a stem 20 (FIG. 15). (Freeman at column 5, lines 55-62, column 6, lines 5-16, and column 6, lines 18-29). The depth locating tool (shown in FIGS. 10-12) is used by placing the pin 58 against the femur and by fitting a fork portion 50 about the upper portion 61 of the rod 60, the projecting end 64 of the reamer 63, or the projecting portion of the stem 20. (Freeman at column 5, lines 55-62, column 6, lines 5-16, and column 6, lines 18-29).

Accordingly, the depth locating tool, which is used to determine the depth of the cavity in the bone by contacting the bone with the pin 58, does not support a cutter or a drive shaft.

Moreover, the only portions of the Freeman devices contacted by the depth locating tool are the upper portion 61 of the rod 60, the projecting end 64 of the reamer

63, and the projecting portion of the stem 20. None of the upper portion 61 of the rod 60, the projecting end 64 of the reamer 63, or the projecting portion of the stem 20 is a “drive shaft.” Specifically, the “drive shaft” of claim 24 must include “a distal end with a second drive joint member, the second drive joint member configured to operably couple with the first drive joint member to rotate the at least one cutter about the cutter axis.”

The only portion of the Freeman device arguably including this limitation is the shaft 34. (See Freeman at column 5, lines 16-20 and at FIG. 15). Therefore, even if the depth locating tool supports the upper portion 61 of the rod 60, the projecting end 64 of the reamer 63, or the projecting portion of the stem 20, none of these components includes the characteristics required of a “drive shaft.”

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Freeman discloses only a single mount, and no structure of Freeman supports the drive shaft. Thus, Freeman does not disclose each and every element of Applicant’s claim 24. Therefore, Freeman does not anticipate claim 24.

### 3. Conclusion

For at least the foregoing reasons, it is respectfully submitted that the rejection of claim 24 as being anticipated by Freeman has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 24 under 35 U.S.C. § 102 should be withdrawn.

*Discussion re: Claim 32*

Claim 32 recites “a bracket assembly configured to (i) support the at least one cutter such that the cutter axis intersects the longitudinal axis at a first angle, and (ii) support the drive shaft at a fixed angular relationship with respect to the frame shaft, wherein the drive shaft axis is about parallel to the longitudinal axis.” As discussed above with respect to claim 24, Freeman does not disclose a bracket which supports the driveshaft 34. Even if the ring 24 is construed to provide any support, such as through the coupling of the shaft 34 and the cutter 26, such support would not be “at a fixed angular relationship” due to the nature of the coupling. (See, e.g., Freeman at column 5, lines 16-20 and FIGs. 6 and 7).

For at least the foregoing reasons, it is respectfully submitted that the rejection of claim 32 as being anticipated by Freeman has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 32 under 35 U.S.C. § 102 should be withdrawn.

*Discussion re: Claim 39*

Claim 39 recites “a cutter mount fixedly attached to the frame shaft and defining a cutter mount axis that intersects the longitudinal axis at a first angle” and “a shaft alignment bracket fixedly attached to the frame shaft and defining a drive axis, the drive axis substantially parallel to the longitudinal axis.” As discussed above with respect to claims 24 and 32, Freeman does not disclose a bracket which defines a drive axis. In fact, the device of Freeman is configured such that the “[s]haft 34 can be adjusted to any suitable angle to allow convenient rotation of the cutter 26.” (See, e.g., Freeman at

column 5, lines 16-20 and FIGs. 6 and 7). An unconstrained drive shaft does not have a drive shaft axis defined by a bracket.

For at least the foregoing reasons, it is respectfully submitted that the rejection of claim 39 as being anticipated by Freeman has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 39 under 35 U.S.C. § 102 should be withdrawn.

*Discussion re: Claims 25-31, 33-38, and 40-44*

Each of the claims 25-31, 33-38, and 40-44 depend, either directly or by way of one or more intermediate claims, from one of claims 24, 32, or 39. Because claims 24, 32, and 39 are patentable over Freeman as discussed above, claims 25-31, 33-38, and 40-44 are also patentable.

**III. 35 U.S.C. § 103 Rejection**

Claim 25 depends from claim 24 and includes all of the limitations of claim 24. Claim 25 was rejected under 35 U.S.C. § 103 as being unpatentable based primarily upon Freeman with further reference to U.S. Patent No. 5,540,694 to DeCarlo, Jr. et al. (hereinafter “DeCarlo”) for the limitations added by claim 25. Therefore, even if Freeman is modified in the manner suggested by the Examiner, such modification fails to correct the deficiencies of Freeman with respect the limitations of claim 24 as discussed above. Accordingly, the proposed modification of Freeman does not arrive at the device of claim 25.

Therefore, for at least the foregoing reason, claim 25 is patentable over the prior art.

#### **IV. Allowable Subject Matter**

The Examiner indicated that claims 27-30, 36-38, 43, and 44 included allowable subject matter. The claims were objected to, however, as depending from a rejected claim. The Applicants respectfully submit that the rejection of the claims from which claims 27-30, 36-38, 43, and 44 depend have been traversed for the reasons set forth above. Accordingly, claims 27-30, 36-38, 43, and 44 are allowable without further modification.

#### **V. Conclusion**

A prompt and favorable action on the merits is requested.

Respectfully Submitted,  
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